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| 09/990,326 | 11/23/2001 | Anthony Derose | PT-1475000 | 2546 |

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[REDACTED] EXAMINER

PATEL, MOTILAL P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3611 | |

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/990,326 | DEROSE, ANTHONY |
| Examiner | Art Unit | |
| Motilal P. Patel | 3611 | |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 mos MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 November 2001 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-55 is/are pending in the application.
 4a) Of the above claim(s) 17-20 and 44-55 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-16 and 21-43 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 November 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7
4) Interview Summary (PTO-413) Paper No(s). ____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Election/Restrictions

During a telephone conversation with Neil H. Hughes on 3/5/03 a provisional election was made without traverse to prosecute the invention of a sign, claims 1-16, and 21-43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-20 and 44-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the abstract the term "said" in lines 3 and 4 is not proper.

Correction is required.

The disclosure is objected to because of the following informalities:

The following numerals shown in drawings are not identified in the specification:

Numerals 6, and 11 (in fig. 2); 7 (in fig. 6); 30, 35 (in fig.10); 43 (in fig.12); 54 (in fig.13) and 63 (in fig.14).

Appropriate correction is required.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

References 5,249,109 and 5,495,147 are not listed in the Information Disclosure Statement.

Drawings

The drawings are objected to for the following reasons:

Fig.3, the terms A, B, C should be designated as 3A, 3B, 3C respectively.

Fig.12, the terms a, b, c, d, should be designated as 12a, 12b, 12c, 12d respectively.

Fig.16, the terms A, B, C, should be designated as 16a, 16b, 16c respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16, and 21-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the terms "preferably", "such as", "may be", "any suitable" render the claim indefinite. In claim 1, line 11, there is no adequate antecedent basis for the term "the powering".

In claims 3, 6, 9, the terms "or the like", "Lexan or the like" render the claim indefinite.

In claim 8, the term "preferably" renders the claim indefinite. The term "international symbol" is not adequately disclosed.

In claim 10, line 2, the term "said a sign" renders the claim indefinite.

In claim 11, is indefinite since it is not clear whether the "one rail" defined is the same as the "supporting rails" defined in claim 10.

In claim 12, the terms "or otherwise", "any desired shape" renders the claim indefinite. Claim 12, line 6, there is no antecedent basis for "said light scattering means" and "said at least....,groove, ridge or characteristic".

In claim 13, line 1, the term "the form", in line 2, the terms "for example", in line 3, the term "or the like" render the claim indefinite. The terms "international symbol" in line 3, and the terms "flat planar body" and "a three dimensional body" in line 5, are not adequately disclosed.

In claim 14, the terms "other light scattering elements" are not adequately disclosed.

In claim 15, line 1, the term "body" should be either "the body" or "said body".

In claim 16, line 1, the terms "suitable electrical conductors" render the claim indefinite.

In claim 21, the terms "such as", "or the like", "suitably oriented", "preferably", "desired shape", "substantially", "a much greater extent than", "compatibly shaped", "pleasing shape(s)", render the claim indefinite. In claim 21, the terms "suitably oriented", "desired shape", "a much greater extent than", "a pleasing and more effective", are not adequately disclosed. In claim 21, line 16, there is no antecedent basis for the terms "the material". In claim 21, line 21, it is not clear whether the terms "a matrix of transparent material" is the same material as defined in line 1.

In claim 22, line 1, the terms, "any colour such as", and in line 2, "or the like" render the claim indefinite. In claim 22, line 3, there is no antecedent basis for "the resultant etching".

In claim 23, the terms "such as", "(preferably using a modular plug like format)", "suitable", "like ornaments", render the claim indefinite. In claim 23, line 2, there is no antecedent basis for "said pairs of wires".

In claim 24, line 1, the terms "dissimilar and complementary" are not adequately disclosed.

In claim 25, line 1, the terms "identical but of alternative colours or colour combinations" are not adequately disclosed.

In claim 26, line 2, the term "may be" renders the claim indefinite. In claim 26, the terms "alternated for different effect" are not adequately disclosed.

In claim 27, the terms "preferably", "or about", "a more uniform", render the claim indefinite. In claim 27, line 7, there is no antecedent basis for "or characteristic".

In claim 28, line 2, the terms "similar or dissimilar ornaments of alternative shape, colour and design" are not adequately disclosed.

In claim 29, the terms, "preferably", "may be", "or the like", "any suitable", "any desired", "can be", "for example", "preferred", "a much greater extent than", render the claim indefinite. In claim 29, line 9, there is no antecedent basis for "said edges". In claim 29, in line 17, there is no antecedent basis for "the display sign". In claim 29, lines 7 and 8, it is not clear whether a single design or plural designs are claimed. In claim 29, lines 9 and 10, the term "proximate" renders the claim indefinite.

In claim 30, the terms "preferred", "not contained within" render the claim indefinite. In claim 30, there is no antecedent basis for, "said edge" in line 2; "the necessary circuitry" in line 3; "the tips" in line 4. In claim 30, in line 4, the terms "light sources being inserted within the openings of said sign or alternatively disposed adjacent thereto in use" render the claim indefinite and it is not clear what is being claimed.

In claim 31, the terms "or otherwise formed", "preferably", "preferred", "a much greater extent than" render the claim indefinite. In claim 31, there is no antecedent basis for "the body" in line 2; "the transparent portions" in line 8.

In claims 34 and 35, the terms "any language or a internationally recognized symbol or design" are not adequately disclosed.

In claim 37, the term "for example" renders the claim indefinite.

In claim 38, the terms "all kinds", "any possible shape or size", "2 or 3 dimensions" render the claim indefinite.

In claim 40, the terms "preferably substantially", "very satisfactory back light depending on" render the claim indefinite.

In claim 41, the terms "may be" in lines 1 and 3, "preferred" in line 3 render the claim indefinite. In claim 41, the terms "of either a smooth glass like material or corrugated material" in line 2, and "alternatively may be glued, clipped or otherwise fastened" in line 4, are not adequately disclosed.

In claim 42, the terms "mirror like" in line 1, "veneer like" and "glass like" in line 2, "for example" in line 3, and "satisfactorily" in line 4, render the claim indefinite. In claim 42, the terms "various textures", "or any texture that reflects/disperses" are not adequately disclosed and it is not clear what is being claimed.

In claim 43, in line 2, there is no antecedent basis for "the group of designs". In claim 43, line 17, the terms "various sizes" are not adequately disclosed.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 12-15, 21-22, 25-27, 29-31, 34-36, 39, 42, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the U. S. Patent (5,743,616) to Giuliano et al.

a. Giuliano in (figs. 1-4) shows the design/sign having a body panel (10) made of plastic as disclosed in column 2, lines 10-11 having sides (10a, 10b, 10c, 10d) with the etched surface (10a) as disclosed in the abstract and in column 2, lines 17-18 and in column 4, lines 18-19 having a design, shape (12) such as art rendering as disclosed in column 1, lines 44-45, and 56-58. Giuliano shows the opening (11), on one side of the body panel (10), in which the light emitting diodes (1) is glued with the transparent material (12). The diode (1) is located proximate to at least one side of the body (10). Giuliano in column 3, lines 18-22, teaches different colored body panel (10).

secondary scattering Giuliano in (fig. 2, 3A, 3B) shows mirrored coating surface (10b, 10c). Giuliano in (figs. 1, 4) shows a switching/timer device (60) for operating the display as disclosed in column 3, lines 18-20 and in column 4, lines 21-22. Giuliano, in column 1, lines 43-45 disclosed the images display such as of any design art. Giuliano shows plurality of light sources (50) in (fig. 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 10-11, 16, 23-24, 28, 32-33, 37-38, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al (U. S. Patent No. 5,743,616) in view of Ming-ho (U. S. Patent No. 5,217,286) or Lee (U. S. Patent No. 6,294,983) or Schunk et al (U. S. Patent No. 6,319,056) or Hawkins (U. S. Patent No. 6,143,381) or Voland (U. S. Patent No. 4,965,701) or Day et al (U. S. Patent (6,296,364)).

Regarding claims 2 and 3, Giuliano does not specifically teach Christmas ornament or Santa Claus or crucifix or a heart, however, Ming-ho, in column 14, lines 37-53 teaches such displays.

Regarding claims 10-11, Giuliano does not teach a pair of supporting rails in a housing, however, Lee in (figs. 1-4) teaches the housing (1) with one rail structure (12) at the top of the sign, however, providing another similar rail structure (12) at the bottom of the sign and separated to receive the display sign (4) would have been obvious to a person having ordinary skill in the art. Lee further teaches light emitting diodes (21) located in the rail structure (1).

Regarding claims 16, 23-24, 28, 32, Giuliano does not teach a string of ornaments, however, Voland, in (figs. 3, 7) teaches the string (14) of ornaments (15). Voland in column 5, lines 3-9, teaches the different sizes, shapes of ornaments.

Regarding claims 33 and 38, Day et al teaches a lighted necklace in (figs. 1-5) and a toy in column 3, lines 16-17.

Regarding claim 37, Giuliano does not disclose the illuminated game elements, however, Ming-ho, in column 14, lines 44-53, discloses the illuminated toys.

Regarding claim 43, Ming-ho, in column 14, lines 44-53, discloses various structures claimed in claim 43 and it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify/combine Giuliano's sign with the teachings of Ming-ho, Voland, and Lee for the claimed structures.

Claims 40, 41, it is too unclear what is being claimed and are not examinable because of severe 35 U. S.C. 112, second paragraph problems.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allen (6,072,280), Hawkins (6,143,381), Lee (6,305,109), Sanders et al (4,693,541), Abramson (4,884,351), Mass et al (US 2001/0049893), Phillips et al (6,094,849), Murasko (6,424,088), Meyer et al (4,171,811), Westmoland (5,201,578), Martin (4,271,457), Rubin (6,428,178), Maleyko (4,915,666) disclose the ornament/design/sign and toys with light emitting surfaces.

Art Unit: 3611

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Motilal P. Patel whose telephone number is 703-305-5141. The examiner can normally be reached on Tues-Fri 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

mp *M.P.*
March 17, 2003

Lesley D. Morris
Lesley D. Morris
Primary Examiner
SPEAN3 611